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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/600,997	06/20/2003	Kenneth P. Murphy	A-71608/TAL/DHR (465174-4)	5773

32940 7590 01/08/2007  
DORSEY & WHITNEY LLP  
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SAN FRANCISCO, CA 94104

EXAMINER
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OUSPENSKI, ILIA I

ART UNIT	PAPER NUMBER
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1644

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/08/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/600,997

Applicant(s)

MURPHY ET AL.

Examiner

ILIA OUSPENSKI

Art Unit

1644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 September 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-63, 74-87 and 91-94 is/are pending in the application.
- 4a) Of the above claim(s) 1-63 and 79-87 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 74-78 and 91-94 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

1. Applicant's amendment/remarks, filed on 09/21/2006, are acknowledged.

Claims 64 – 73 and 88 – 90 have been cancelled.

Claims 93 – 94 have been added.

**Claims 1 – 63, 74 – 87, and 91 – 94 are pending.**

Claims 1 – 63 and 79 – 87 stand withdrawn from further consideration by the Examiner, under 37 C.F.R. § 1.142(b), as being drawn to nonelected inventions, there being no allowable generic or linking claim.

***Claims 74 – 78 and 91 – 94 are under consideration in the instant application.***

2. This Office Action will be in response to applicant's amendment and arguments, filed on 09/21/2006.

The rejections of record can be found in the previous Office Action, mailed on 03/21/2006.

The text of those sections of Title 35 USC not included in this Action can be found in a prior Office Action.

It is noted that New Grounds of Rejection are set forth herein.

***3. The objections and rejections of record have been withdrawn in view of Applicant's amendment and arguments, except as set forth herein.***

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4. Applicant's Declaration under 37 CFR 1.131, by Drs. K. Murphy, T. Murphy, N. Watanabe, and J. Yang, filed on 09/22/2006, is acknowledged, and has been entered.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112.

*The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.*

6. Claim 74 – 78 and 91 – 94 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. Claim 76 is indefinite, because it does not clearly set forth method steps, there being an absence of a positive resolution or correlation step, which reads back on the preamble of the claimed methods. Therefore, one of ordinary skill in the art would not be reasonably apprised of the metes and bounds of the claimed invention.

Applicant is invited to incorporate the resolution step recited in claim 77 into claim 76.

B. Claims 74 – 78 and 91 – 94 are indefinite in the recitation of "association" in claim 91, because the metes and bounds of the recitation are unclear. Neither the claims nor the specification define the term "association," and one of ordinary skill in the

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art would not be reasonably apprised whether it encompasses direct or indirect interaction, or co-location within the same cell, or within the same subject. The use of the term at page 44, line 5, indicates that it is intended to encompass both covalent and non-covalent interactions, which appears inconsistent with the context of the claim. Therefore, one of ordinary skill in the art would not be reasonably apprised of the metes and bounds of the claimed invention.

Applicant is reminded that any amendment must point to a basis in the specification so as not to add new matter. See MPEP 714.02 and 2163.06.

7. Claim 74 – 78 and 91 – 94 are rejected under **35 U.S.C. 102(e)** as being anticipated by Clark et al. (US Patent No. 7,153,950; see entire document).

It is noted that US Patent No. 7,153,950 is based on application USSN 10/371,341, which was published as US Pat. Pub. No. 2004/0091884. The present rejection is essentially a reiteration of the rejection of record, set forth in the Office Action mailed on 03/21/2006, based on Clark et al. (US Pat. Pub. No. 2004/0091884). The rejection of record is incorporated by reference herein, as if reiterated in full.

Clark et al. (US Patent No. 7,153,950) **claim** an isolated recombinant nucleic acid (SEQ ID NO:1, see claims 1 – 3) which is 98.2% identical to the instantly claimed SEQ ID NO:7, and encodes a polypeptide which is 100% identical and 97.4% identical to the instantly claimed SEQ ID NO:6 and 8, respectively, as shown by the alignments attached to the previous Office Action. Clark et al. further claim expression vectors comprising said nucleic acid, host cells comprising said vectors, and methods of producing the polypeptide encoded by said nucleic acids using host cells comprising the vectors (claims 4 – 8).

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Applicant relies on the Declaration under 37 CFR 1.131, by Drs. K. Murphy, T. Murphy, N. Watanabe, and J. Yang, filed on 09/22/2006, to overcome the rejection of record over Clark et al. (US Pat. Pub. No. 2004/0091884). The declaration is deemed to be ineffective in overcoming the present rejection, for the following reasons:

The Clark et al. (US Patent No. 7,153,950) reference is a U.S. patent that claims the rejected invention. An affidavit or declaration is inappropriate under 37 CFR 1.131(a) when the reference is claiming the same patentable invention, see MPEP § 2306. If the reference and this application are not commonly owned, the reference can only be overcome by establishing priority of invention through interference proceedings. See MPEP Chapter 2300 for information on initiating interference proceedings. If the reference and this application are commonly owned, the reference may be disqualified as prior art by an affidavit or declaration under 37 CFR 1.130. See MPEP § 718.

**8. Conclusion: no claim is allowed.**

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ILIA OUSPENSKI whose telephone number is 571-272-2920. The examiner can normally be reached on Monday-Friday 9 - 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on 571-272-0841. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ILIA OUSPENSKI, Ph.D.

Patent Examiner

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December 28, 2006

*Phillip Gandel*  
PHILLIP GANDEL, PH.D. JD  
PRINCIPAL EXAMINER

*12 1600*

*12/30/06*